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| 09/872,293      | 05/31/2001  | G. Eric Engstrom     | 112076-138338       | 2368             |

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EXAMINER

THEIN, MARIA TERESA T

ART UNIT PAPER NUMBER

3627

DATE MAILED: 12/29/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/872,293

Applicant(s)

ENGSTROM, G. ERIC

Examiner

Marissa Thein

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 07 October 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-37 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-37 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

**DETAILED ACTION**

***Response to Amendment***

Applicant's "Amendment" filed on October 7, 2005 has been considered.

Claims 1, 15, 22, and 29 are amended. Claims 1-37 remain pending in this application.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

**Claims 1-2, 7-8, 10-16, 19-23, 26-30, and 34-37 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent Application Publication No. 2002/0013739 to O'Donnell et al. in view of U.S. Patent Application No. 2002/0022967 to Ohkada.**

Regarding claims 1, 15, 22, and 29, O'Donnell discloses an electronic delivery address service method, storage medium, an apparatus, and system comprising:

- the receiving by the delivery address service via electronic communication, an electronic subscription from a subscriber, the received subscription including a mailing address of the subscriber (see at least paragraphs 11-12; 26; 92; 108; 125-127; 130; 132);

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- in response, the delivery address service the electronically generating the subscriber with a substitute delivery address (see at least paragraphs 29; 55; 108; 139; 158; 262);
- the receiving by the delivery address service an electronic notification of either a request to deliver or an arrival of the purchased goods in an online purchase of the goods (see at least paragraphs 11-12; 26; 37; 87); and

However, O'Donnell does not explicitly disclose transmitting by the delivery address service the substitute delivery address to the subscriber, for the subscriber to use in an online purchase of a good and the intervening by the delivery address service by electronically accessing and communicating the mailing address provided by the subscriber as part of the electronic subscription to a delivery service to facilitate delivery of the purchased goods to the subscriber at the mailing address of the subscriber , wherein the mailing address accessed and communicated by the delivery address service is retrieved from a database of said delivery address service. O'Donnell discloses an anonymous shipping services by concealing the identity of the purchaser or the recipient of goods, products, and/or services. The user can make a purchase of goods, products/ and/or services, and arrange for the anonymous shipment of the goods so as to conceal the user's identify and shipment address from the provider (paragraph 253). The user database contains subscription information, subscriber information and membership information (paragraph 177). O'Donnell discloses each third party shipper computer 60 can be utilized to transmit information to and received information from shipper computers 40 (paragraph 114). The third party shipper

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computer comprises a database which containing the user's (subscriber) name and address (paragraph 237).

Ohkado, on the other hand, teaches the transmitting by the delivery address service the substitute delivery address to the subscriber, for the subscriber to use in an online purchase of a good (paragraph 20; paragraph 60); and the intervening by the delivery address service by electronically accessing and communicating the mailing address provided by the subscriber as part of the electronic subscription to a delivery service to facilitate delivery of the purchased goods to the subscriber at the mailing address of the subscriber, wherein the mailing address accessed and communicated by the delivery address service is retrieved from a database of said delivery address service (paragraph 23; paragraph 37; paragraphs 81-83; Figure 1 and Figure 5)

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention was made to modify the method, medium, apparatus, and system to O'Donnell, to include the transmitting and the intervening, as taught by Ohkado, in order to ensure the anonymity of customers during the delivery of purchase (Ohkado, paragraph 15).

Regarding claims 2, 16, 23, and 30, O'Donnell discloses the correlation of the substitute delivery address to the mailing address of the subscriber (see at least paragraphs 29; 55; 139).

Regarding claims 7-8, 19-20, 26-27, and 34-35, O'Donnell discloses wherein the substitute delivery address comprises one of a plurality of virtual delivery address artificially created by the delivery address service (see at least abstract; paragraphs

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139; 158); the receiving of a notification of a request to deliver a purchased good from a delivery service, and the providing the mailing address of the subscriber to the delivery deliver service (see at least paragraphs 17; 134-135; 158; 265).

Regarding claims 9 and 36, O'Donnell and Ohkado substantially discloses the claimed invention, specifically, the delivery address service providing the mailing address of the subscriber to the delivery service (O'Donnell, see at least paragraphs 265-267).

However, the combination does not explicitly disclose the automatically providing of the mailing address of the subscriber to the delivery address. It was known at the time of the invention that merely providing an automatic means of providing the mailing address to replace a manual activity which accomplishes the same result is not sufficient to distinguish over the prior art, *In re Venner*, 262 F.2d 91, 95, 120 USPQ 193, 194 (CCPA 1958). In other words there is no enhancement found in the claim recited. The end result is the same as compared to the manual activity.

It would have been obvious to one of ordinary skill in the art at the time of the invention was made to automatically provide the mailing address without requiring the delivery address service to explicitly request since it has generally been recognized that merely providing an automatic means to replace a manual activity which accomplishes the same request is not sufficient to distinguish over the prior art.

Regarding claims 10-12, 21, 28, and 37, O'Donnell discloses the receiving a confirmation by the deliver address service of the purchase (see at least paragraph 33; 71; 137; 264); wherein the delivery address service receives the confirmation form the

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subscriber (see at least paragraph 33; 71; 137; 264); and receives the confirmation from an online business from which the goods to be delivered was purchased (see at least paragraph 33; 71; 137; 264).

Regarding claims 13-14, O'Donnell discloses the subscriber is a purchaser of the goods; or a beneficiary of the purchaser (see at least paragraph 90).

**Claims 3-6, 17-18, 24-25, and 31-33 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent Application Publication No. 2002/0013739 to O'Donnell et al. and U.S. Patent Application No. 2002/0022967 to Ohkada as applied to claims 1, 15, 22, and 29 above, and further in view of U.S. Patent Application No. 6,336,100 to Yamada.** O'Donnell and Ohkada substantially discloses the claimed invention, however, the combination does not explicitly disclose the mailboxes and the mailbox proximately located with the mailing address of the subscriber. The combination discloses the method and apparatus for providing anonymous shipping services (O'Donnell, paragraph 2). The combination discloses the apparatus includes one or more shipping service provider computer and one or more third party shipping service provider computers (O'Donnell, paragraphs 17 and 19). The shipper can be carrier, delivery service provider, shipping service provider, and transporter (O'Donnell, paragraph 92). The third party shipper can be third party carrier, third party shipping service provider, third party delivery service provider, etc (O'Donnell, paragraph 94). Furthermore, the combination discloses tracking information which include name of shipping party and address information, name of receiving party and the address information, etc. (O'Donnell, paragraph 202).

Yamada, on the other hand, teaches the mailboxes and the mailbox proximately located with the mailing address of subscriber (col. 1, lines 11-15; col. 1, lines 22-44).

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention was made to modify the combination, to include the mailbox the mailbox proximately located with the mailing address of subscriber, as taught by Yamada, so as to provide a place that is most convenient for the customer (Yamada, col. 6, lines 10-31).

### ***Response to Arguments***

Applicant's arguments with respect to claims 1-37 have been considered but are moot in view of the new ground(s) of rejection.

Applicant remarks that the cited references (O'Donnell and Stolfo) individually or in combination do not teach or suggest the claimed feature of "the intervening by the delivery address service by electronically accessing and communicating the mailing address provided by the subscriber as part of the electronic subscription to a delivery service to facilitate delivery of the purchased goods to the subscriber at the mailing address of the subscriber , wherein the mailing address accessed and communicated by the delivery address service is retrieved from a database of said delivery address service".

The Examiner directs Applicant's attention to the Office Action above.

### ***Conclusion***

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP



§ 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Marissa Thein whose telephone number is 571-272-6764. The examiner can normally be reached on M-F 8:00-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Alex Kalinowski can be reached on 571-272-6771. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Mtot  
December 21, 2005

A handwritten signature in black ink, appearing to read "S B McAllister".

STEVE B. MCALLISTER  
PRIMARY EXAMINER